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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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LM02/0427

EXAMINER

COSIMANO, E

ART UNIT PAPER NUMBER

2761

DATE MAILED: 04/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/003,941

Applicant(s)

Polk

Examiner
EDWARD COSIMANO

Group Art Unit
2761



☒ Responsive to communication(s) filed on Mar 30, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 142-211 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 142-211 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jan 7, 1998 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on 01/08/98 & 03/30/99 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.

2. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data on page 1,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

Appropriate correction is required.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, & § 1.84(o,p(5)).

4. Claims 122-211 are provisionally rejected under the judicially created doctrine of double patenting over claims 39-60, 62-76 & 78-88 of copending Application No. 08/941,187. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

4.1 The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the use of electronic data interchange (EDI) messages when processing of a electronic funds transfer (EFT) where the EDI messages contain multiple parts which must be parsed before the EFT can take place.

4.2 Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

5.1 Claims 150-153, 166 & 175 are rejected under 35 U.S.C. § 101 because the invention as

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claimed is directed to non-statutory subject matter.

5.1.1 Although the instant claims recite:

1) a system/device, (claims 150-153, 166 & 175), which has a practical application in the technological arts, and

2) which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon,

the instant claims merely define device which contains a series of steps to be performed on a computer.

5.1.2 It is further noted that applicant has not recited a specific machine since:

A) although a high level program is provided and recited in the claims to illustrate the operations of the instant invention this program is not implemented on a general purpose computer.

Hence, applicant envisions the invention as recited in claims 150-153, 166 & 175 as a disembodied storage device, i.e. memory. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, and

B) a memory alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

5.1.3 It is noted that claims 150-153, 166 & 175 fail to recite either:

A) pre computer processing, since the claims fail to recited that the data, which originates from an unknown source, is manipulated or changed before it is processed, or

B) post computer processing, since the claims fail to recited that the data which represents the result of the claimed manipulation is either manipulated or changed by any device after it has been processed.

5.1.4 Therefore, claims 150-153, 166 & 175 merely describe an abstract idea of a disembodied

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storage device, which itself can not perform the functions recited within the claims as the invention, and hence, which does not have a claimed practical application. These claims fail to recite a practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

5.1.5 Hence, claims 150-153, 166 & 175 are directed to non-statutory subject matter.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.1 Claims 142-211 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Anderson (5,283,829) or Hilt et al (5,465,206).

6.2 Claims 142-211 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Landry (5,649,117).

6.3 In regard to claims 142-211, any one of either Anderson ('829) or Hilt et al ('206) or Landry ('117) disclose a system which uses electronic data interchange (EDI) messages to transfer funds in order to disburse payments to various receivers through the common ordinary paths of making payments, i.e. banks, ACH etc. These EDI messages contain multiple parts which include electronic funds transfer (EFT) data as well as user instructions, i.e. addendum. It is noted that the addendum information may include other EFT data which must occur before the original EFT can take place.

6.3.1 The EFT transaction may be of any suitable nature so as to ensure the proper transfer of the required funds.

7. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

7.1 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE

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EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

8. Response to applicant's arguments.

8.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

8.2 As per the double patenting rejection, since:

A) the instant claims still recite common subject matter and would extend applicant's monopoly of the copending Application No. 08/941,187, applicant's argument's are non persuasive.

8.3 As per the 35 U.S.C. § 102 rejection, since:


A) the instant claims still recite the use of EFT and EDI to transfer funds, as does the applied art, applicant's argument's are non persuasive.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703)-305-9714. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

9.1 The fax phone number for UNOFFICIAL FAXES for this group is (703) 305-0040.

9.2 The fax phone number for OFFICIAL FAXES for this group is either (703) 308-9051 or (703) 308-9052.

04/24/99


Edward R. Cosimano
Primary Examiner A.U. 2761